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IN THE
Supreme Court of the United States

OCTOBER TERM, 1948

No. 183

REMINGTON RAND, INC.,

Petitioner,

v.

ROYAL TYPEWRITER COMPANY, INC.,

Respondent.

**BRIEF FOR RESPONDENT IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI**

This case does not present a situation justifying the grant of the petition. The concurrent decisions below finding infringement applied the law as established by many decisions of this court extending over a period of nearly a century to a situation coming clearly within its compass; no doubtful question of law is involved or even the application of the law to a borderline case. And the enforcement of the patent against this particular petitioner is not a matter of importance to the typewriter industry at large.

The Decisions Below and the Question of Law Involved

The patent in suit is for an improvement in margin regulators for typewriters. Claims 1 to 3 inclusive are in suit. While petitioner did not contest validity in either of the courts below, the district court examined the prior art and

found that the patented improvement "was a decided improvement in stop-setting mechanisms" (R. 235, f. 704) and "a substantial advance in the art" (R. 242, f. 724). On these and other findings, it held the patent valid (R. 247). The Court of Appeals, while accepting petitioner's concession of validity (R. 256), concurred with the district court in its appraisal of the value of the improvement. After noting that typewriters "on which a vast amount of ingenuity had been expended * * * had for long offered a place for just such an improvement", the Court of Appeals said:

"Moreover, although the record amply proves that 'margin stops' themselves had received much attention and been the subject of a number of patents, nobody had ever before worked out their automatic return and that was a change which has proved of substantial service" (R. 258).

On the issue of infringement, the main defense was that petitioner's device does not correspond to the literal language of the claims in two respects (see italicized portions of items 7 and 9 of claim 2, petition, opposite p. 7. Similar provisions appear in claims 1 and 3.)*

Only the first suggested non-correspondence is pertinent here, since in respect of the "second supposed departure" (item 9 of claim 2) the Court of Appeals did not find it necessary to "invoke the 'doctrine of equivalents' at all" (R. 259). The court found that infringement of this item of the claim "is well within any but a deliberately hostile interpretation of the claims" (R. 259). The second point relied on is, therefore, not pertinent to the petition, which rests on an alleged misapplication of the "doctrine of equivalents".

* Item 8 is also italicized but this provision only appears in claim 2. It was not considered by the Court of Appeals since it would not affect the decision as to claims 1 and 3. For the district court's discussion of this minor point, see R. 239-240.

The application of the doctrine of equivalents was made in connection with the provision in the claims for a pair of trip members or bars (item 7 of claim 2, for instance). The object of the Woodfine invention was to do away with the inconvenient manual setting of margin stops and to provide a device which would automatically move margin stops to the desired margin position. Woodfine accomplished this by "motorizing" the margin stops by means of a spring and providing tripping means operable by the operator from the front of the machine to release selectively the catch on the margin stops. The tripping means serve to release selectively the catch of the margin stop and hold the catch released while the margin stop, under the urging of the spring, automatically springs to the desired margin position. In his disclosure, Woodfine shows two trip bars for his tripping means and the claims specify a pair of trip members.

Petitioner substituted "a single bar with two tripping surfaces" for "the two trip bars shown by Woodfine" (R. 246, F. 19). This single bar with two trip surfaces was a known instrumentality for selectively releasing the catches on margin stops. It is shown in the Olivetti patent in a different combination (R. 189, particularly Fig. 8), as petitioner admitted below.

Both courts found that petitioner's single bar with two trip surfaces operates in substantially the same way to obtain substantially the same result and is the mechanical equivalent of the patent's two trip bars (District Court, R. 239; 242, f. 725; Court of Appeals, R. 258).

Applying the doctrine of equivalents, the Court of Appeals held that the character of Woodfine's contribution entitled him to protection "against so complete an appropriation as the defendant has made" (R. 258). The district court, in finding infringement, held that "confining him [Woodfine] to plural trip members would be a complete denial of the doctrine of equivalents" (R. 242).

The doctrine of equivalents is one of the oldest and most firmly established in the patent law. It lies at the heart of the patent system. It comes into play on questions of patentable novelty or invention (*Smith v. Nichols*, 21 Wall. 112, 119) as well as on questions of infringement. The doctrine stems from the sound legal principle that courts will give consideration to the substance of things and refuse to be bound rigidly by the mere name or form with which the parties may choose to clothe them. One of the classic statements of the rule is given by Justice Clifford in *Machine Co. v. Murphy*, 97 U. S. 120, 125.

As applied to questions of infringement, the rule cuts both ways. There may be no infringement even though there is verbal correspondence with the claims and, conversely, a mere colorable variation will be held an infringement even though literal correspondence may be avoided. *Bates v. Coe*, 98 U. S. 31, 42; *Westinghouse v. Boyden*, 170 U. S. 537, 568. Literal correspondence to the claims is not made the absolute test but consideration is also given as to whether there has been a substantial appropriation of the invention.

This court has repeatedly over the last hundred years applied the doctrine to hold as infringements mere colorable evasions of the claim.* Any other rule would make piracy of inventions a habit.

As the doctrine is equitable in character, its limits cannot be precisely defined and doubtless it should in all cases be applied with caution. There is one situation, how-

* *Winans v. Denmead*, 15 How. 330, 342; *Seymour v. Osborne*, 11 Wall. 516, 560; *Ives v. Hamilton*, 92 U. S. 426, 431; *Imhaeuser v. Buerk*, 101 U. S. 647, 655-6, 662-4; *Clough v. Barker*, 106 U. S. 166, 176-7; *Hoyt v. Horne*, 145 U. S. 302, 308-9; *Potts v. Creager*, 155 U. S. 597, 600, 609; *Cash Reg. Co. v. Cash Indicator Co.*, 156 U. S. 502, 517; *U. S. v. Berdan etc. Co.*, 156 U. S. 552, 566; *Continental Paper Bag Co. v. Eastern etc. Co.*, 210 U. S. 405, 421; *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30, 42.

ever, which the courts have "with curious unanimity," as Judge Hand remarked below (R. 259), always held to come within the purview of the doctrine. That situation and the reasons for applying the doctrine to it are given by Judge Learned Hand in *Gibbs v. Triumph Trap Co.*, 26 F. 2d 312, 314:

"It is settled law, and it is good sense, that one does not escape infringement by combining into one element what a *claim specifies as two*, provided that the single element performs the function of both in the same way." (Emphasis ours.)

* * *

"When a patentee prescribes two elements in a claim he means that each will contribute its share of the result, but their duality is not important. When the two are incorporated into a single physical element, it remains as much a means to the first result and a means to the second, as though it were in two parts. Were this not true, any ingenious mechanic might pick an inventor's brains at pleasure."

Like decisions are so numerous that the Court of Appeals below confined itself to citing its own (R. 259). Decisions of like tenor in other courts are listed below.*

* *Seymour v. Osborne*, 11 Wall. 516, 560; *Clough v. Barker*, 106 U. S. 166, 177-8; and see companion case on defendant's improvement patent, 106 U. S. 178 at p. 180; *Mershon v. Sprague* (C. C. A. 1), 92 F. 2d 313, 317; *Courson v. Westinghouse etc. Co.* (C. C. A. 3), 263 Fed. 89, 94-5; *Kalamazoo etc. Co. v. Duff Mfg. Co.* (C. C. A. 6), 113 Fed. 264; *Nathan v. Howard* (C. C. A. 6), 143 Fed. 889, 893; *Bundy Mfg. Co. v. Detroit etc. Co.* (C. C. A. 6), 94 Fed. 524, 538; *Apex Electrical Mfg. Co. v. Maytag Co.* (C. C. A. 7), 122 F. 2d 182, 187; *Sears, Roebuck & Co. v. Delta Mfg. Co.* (C. C. A. 7), 78 F. 2d 745, 747; *Simplex Appliance Co. v. Star etc. Co.* (C. C. A. 7), 37 F. 2d 491, 492; *U. S. Ozone Co. v. U. S. Ozone Co. of Am.* (C. C. A. 7), 62 F. 2d 881, 889; *Hydraulic etc. Co. v. Williams etc. Co.* (C. C. A. 7), 165 F. 2d 489, 492; *N. Y. Scaffolding Co. v. Whitney* (C. C. A. 8), 224 Fed. 452, 463; *Pedersen v. Dundon* (C. C. A. 9), 220 Fed. 309, 311; *Bianchi v. Barili* (C. C. A. 9), 168 F. 2d 793, 801-2, 78 U. S. P. Q. 5, 11.

Thus, the present situation has long been recognized by repeated decisions as coming within the scope of the doctrine of equivalents. The application of the doctrine of equivalents here was not to a borderline case at all; it was not a "loose" or "uncertain" (Pet. 24, 25) but a chaste application of the doctrine. Failure to find infringement would, as the district court held, have been a "complete denial of the doctrine of equivalents". A more limited application of the doctrine can hardly be imagined. Indeed, its application here does little more than to interpret the terms of the claims realistically since it would be an interpretation not unreasonable and conforming to substance to hold that the two tripping surfaces of petitioner's single bar constitute, in fact, a pair of trip members, as specified by the claims.

There clearly has been no new, unusual or erroneous application of the doctrine of equivalents in this case.

**The Question of Law Posed by the Petition
is Not Presented by the Present Case**

Although petitioner professes not to seek a review of the facts (Pet. 16), its statement of the case is at many points directly at variance with the concurrent findings of the lower courts. As a result a very different case is presented by the petition from that passed upon by the courts below.

First, petitioner repeatedly asserts that the patent is for a "minor" improvement in a crowded art (Pet., p. 16; see also pp. 4, 11, 24, 27; note however that at another point petitioner inconsistently refers to it as a dominating patent, Pet., p. 9). While both of the lower courts recognized that the patent was not of a pioneer character, they both held that the invention was a substantial advance in the art (see *ante*, p. 2).

Akin to this are petitioner's repeated averments that the patent is a mere paper patent (Pet., pp. 4, 10, 11, 16,

27, 28). But this is in conflict with the district court's finding (R. 245, F. 15). In the companion *Smith* case, the Judge said that the patent could not be "considered purely a 'paper' patent" (76 F. Supp. 190, at 193).

Petitioner also predicates its argument on the assertion that its device is fundamentally different and superior to the device of the Woodfine patent (Pet., pp. 7, 11, 13, 16, 27). But the district court found that petitioner's device "is substantially identical therewith in structure" (R. 246, F. 21) and the Court of Appeals characterized the slight differences in operation of the two devices as "inconsequential" (R. 258, ~~259~~ 259).

Akin to the the above assertion are petitioner's assertions that its device "departs substantially from the terms of the claims" (Pet., pp. 11, 13, 16). But the district court held the variations to be "immaterial" (R. 246, F. 21), and the Court of Appeals said the patent "is entitled to be protected against so complete an appropriation as the defendant has made" (R. 258).

It is upon the above assertions that petitioner bases its argument of unduly broad interpretation of the doctrine of equivalents and that it was loosely applied through the use of uncertain criteria (Pet., pp. 24-25). The argument is all beside the point, for the case posed is not the case decided below.

No Question of File Wrapper Estoppel is Involved

In its fourth point of argument (Pet., pp. 29-30), petitioner seeks to convey the impression that a question of file wrapper estoppel is involved. If such a question were really involved, it is certain that the experienced judges who decided the case below would not have ignored such an important point. The fact is that the contention is entirely without merit.

The application as filed contained five claims, the first of which was so broadly phrased as to cover the usual

manual margin regulator in standard use. It was rejected on the Buckingham patent which shows a specific form of the standard manual margin regulator. The claim was rightly rejected and was immediately cancelled. The remaining claims, with only minor amendments to present claims 2 and 4, were allowed as filed (R. 214-5).

Petitioner suggests that the rejection of this broad claim in some way restricts the remaining claims to their exact terminology. They do not explain why this should be so and do not cite any supporting authority. No file wrapper estoppel can arise here because *manual margin* regulators are not involved. Respondent does not seek to reach by the issued claims what was abandoned in original claim 1. That is as far as the file wrapper estoppel cases go.

Petitioner also refers to the cancellation of a conventional clause regarding permissible variations frequently included in specifications. This clause was "unnecessary since the law would secure him against imitation by other forms and proportions" (*U. S. v. Anciens Etablissements*, 224 U. S. 309, 328) and the voluntary cancellation of this clause, mere surplusage at best, has no significance. *Heap v. Greene* (C. C. A. 1), 91 Fed. 792, 794.*

**The Enforcement of the Patent Against
Petitioner is not a Matter of Importance
to the Typewriter Industry at Large**

The legal questions passed upon in the case present no question of public importance for, as we have seen, the law is old and established and was correctly applied. Nor

* There is reason to believe that this clause was accidentally cancelled instead of the paragraph immediately preceding it (see R. 204), for this other paragraph, after the deletion of the immediately preceding matter, is left dangling. However, it is clear that the cancellation of the clause in question was not required by the Patent Office (see only Office action, R. 213-4).

is the enforcement of the patent against petitioner a matter of importance to the typewriter industry at large.

The patent clearly does not dominate the typewriter industry as petitioner suggests (Pet., p. 9). It relates to a convenient accessory for typewriters. It is a valuable one but it is not essential to typewriter operation. It has not been used at all by several companies, e.g. Underwood, I.B.M. and Woodstock, and is not used by petitioner itself on its portable and noiseless typewriters which comprise a substantial part of its typewriter business.

No additional infringers exist to be subject to or affected by the decision during the remaining life of the patent. Because of certain dealings between respondent and L. C. Smith & Corona Typewriter Company, the only other concern held to have infringed (see 76 F. Supp. 190), the district court granted L. C. Smith a license on reasonable royalty terms in the memorandum decision referred to in the petition (p. 6). Thus, the only concern which will be restrained by the decisions on the patent is petitioner.

The figures and percentages given in the Widdoe affidavit (Pet., p. 32) are irrelevant because they fail to show the percentage relating to petitioner's infringing business which is the only business to be restrained. In addition, we note that the percentage figures given are greatly inflated because they exclude portable, noiseless and electric typewriters which together are sold in nearly as great quantities as standard typewriters.

In view of the above facts, it is immaterial that typewriter manufacturers are either located in or amenable to suit in the Second Circuit since the decision is only of importance to petitioner and respondent. Such a private litigation has never been of interest to this court. The element of industry dominance by a patent, which was a factor in leading the court to grant certiorari in the cases cited by petitioner (Pet., p. 15), is lacking here.

We also suggest that the reason which led the court to grant certiorari in those cases affecting an entire industry where it appeared that all were amenable to suit in one circuit has lost much of its justification now with the adoption of the declaratory judgment act and the liberalization of the venue statutes effective September 1, 1948. The patent owner no longer has sole control over the choice of the forum. A wide choice is given a patent opponent and the possibility of a patent owner being able to restrict litigation to one circuit is remote indeed.

No questions of laches or estoppel are involved here. Petitioner does refer to its asserted reliance on opinion of counsel (Pet., pp. 6-7). But that opinion shows that counsel anticipated the possibility of patent litigation for the stated reason that petitioner's construction "is not too far removed from the Woodfine" patent (R. 228). Petitioner was promptly served with an infringement notice after it placed the infringing apparatus on the market and it was promptly sued after petitioner indicated its intention to pursue its course.

Respectfully,

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